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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/657,442	09/08/2003	Dov L. Randall	0112300-1627	1420
29159 7590 03/26/2008 BELL, BOYD & LLOYD LLP P.O. Box 1135 CHICAGO, IL 60690				
EXAMINER RENDON, CHRISTIAN E				
ART UNIT		PAPER NUMBER		
3714				
NOTIFICATION DATE		DELIVERY MODE		
03/26/2008		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PATENTS@BELLBOYD.COM

### Office Action Summary

**Application No.**

10/657,442

**Applicant(s)**

RANDALL ET AL.

**Examiner**

CHRISTIAN E. RENDÓN

**Art Unit**

3714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE \_\_\_\_\_ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_\_.  
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☐ Claim(s) \_\_\_\_\_ is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

This office action is in response to the amendment filed on December 14, 2007 in which applicant amends claim 1, 10, 18, 37, 48, 56-58, 62 and 66-67, cancels claims 5, 13, 22, 32, 41, 52, and responds to claim rejections. Claims 1-4, 6-12, 14-21, 23-31, 33-40, 42-51, 53-67 are pending.

### ***Claim Rejections - 35 USC § 103***

**Claims 1-4, 6-12, 14-21, 23-31, 33-40, 42-51, 53-67 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baerlocher et al. (US 2003/0036419 A1) in view of one having ordinary skill.**

1. Regarding claims 1, 10, 18, 29, 37, 48, 56-58, 62 and 66-67, Baerlocher discloses a primary or triggered bonus or secondary game that randomly generates or selects a plurality of digits of an award (abstract). The game instructs the player to use the digits to create a range of possible awards or offers (fig. 3b) therefore the digits are viewed as offer components. The game machine's processor is programmed to randomly generate several numbers for activation as offer components (par. 10, lines 5-6). An offer component is activated and displayed when a player selects it (fig. 3D, 120). A player determines the position for each masked number or offer component with respect to the final offer thus creating and displaying an award based on all of the selected award values (par. 10, lines 10-12). At this point the player is given a choice to accept or reject the offer (par. 18, lines 1-3). The preferred embodiment of the game randomly decides on a modification method to apply on the award when the player rejects the offer (par. 19, lines 2-5). Therefore at least one component modifier is selected and displayed (fig. 9). Once the modification process is complete a new award is displayed and available to the player (par. 114, lines 6-7).
2. The included modification methods that change the state of an offer component are scrambling the digits, regenerating the award, subtracting or adding a digit and multiplying an award (par. 19, lines 6-9). The regeneration of the award is the only modification that is viewed as a "change of

selection of a number of said selected offer components" as described in claims 18 and 29. The subtraction of a digit is the only modification that unselects a number or offer component based on the number or value of the component (par. 22, lines 5-7), therefore it is viewed as a modifier associated with a negative value or effect because of the impact it creates is undesirable (par. 130, lines 6-10). The addition of a digit (par. 125, lines 11-12) and the multiplication of the award (par. 135, lines 7-8) will always increase the award and are both highly desirable since the modifiers are associated with a positive value or effect.

3. Furthermore, the multiplication modifier is the only modifier that requires a value hence the association with a value (fig. 13). Therefore the prior art fails to teach two of the applicant's limitations: containing only different modifying components associated with values and displaying all of them at once. However the Office views the prior art's teaching of one modifying components associated with a value sufficient for one having ordinary skill in elementary math to include other mathematical operations that require values. Furthermore the Office views the limitation of a game containing only modifiers associated with a value then a mix of modifiers as taught by the prior art as mere design choice. Since the same problem of providing a consequence for rejecting an award is still solved by both games. Additionally the displaying of all possible modifiers at once to a player is also viewed as mere design choice since in both game the player has no say in which modifier will be used therefore each game takes a different approach on 'building suspense' as unknown (prior art) or identified (applicant) consequences.

4. Regarding claim 2, 11, 19, 30, 38, 49, 61 and 65, figure 8 of the prior art demonstrates the occurrence of an event that allows the player to accept [keep] (fig. 8, 166) or reject [modify] (fig. 8, 164) an offer provided by the preferred embodiment (par. 19, lines 2-5).

5. Regarding claims 3-4, 12, 20-21, 31, 39-40 and 50-51, in one of the preferred embodiments the game displays three masked numbers (Fig. 3B, 116) (par. 56, lines 6-8) or offer components

since each one is a piece of a final offer. A player is allowed to decide how to organize the pieces or components by selecting or activating a masked number's digit location.

6. Regarding claims 6-8, 14-16, 23-25, 33-35, 42-44 and 53-55, the prior art illustrates in figure 5 that a probability is associated with each masked number and is stored in a database (par. 77, lines 1-2). The numbers are all weighted differently and the game machine is programmed to assign 50% of the time 0-3 as an offer component (par. 78). Therefore a player is more likely to receive an award of lower value.

7. Regarding claim 9, 17, 26, 36 and 45, the game machine offers awards associated with each offer component and the total range of possible awards is equal to  $^{10}P_3 = 720$ .

8. Regarding claims 27-28, the prior art discloses a device having several modification methods at its disposal when a player selects to modify or reject the current award (par. 19, lines 2-5). Furthermore, the modifier is selected after the player selects or presses the modify button.

9. Regarding claim 46, the art discloses several possible modifiers that the game can select from and each possible modifier has a value or effect attributed to each one. As stated above, addition and multiplication always have positive effects, regeneration and scrambling are considered to have neutral effects since a player cannot allow depend on positive results and subtraction of a digit always has negative effects. Therefore the prior art discloses a game selecting a modifier from a range of effects or values.

10. Regarding claim 47, the prior art claims that each possible modifier is selected based on a probability stored in a memory device (par. 112, 119, 124, 129, 134, lines 1-3).

11. Regarding claims 59-60 and 63-64, the art discloses a modification that subtracts a digit, in other words unselects a number or offer component based on the number or value of the component (par. 22, lines 5-7). Since the value of an award is always lowered this modifier is associated with a negative value or effect and is considered very undesirable (par. 130, lines 6-10). Fortunately, the

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modifier unselects the number of the lowest value (par. 22, lines 5-7); therefore the offer component that contains the lowest number is associated with the negative value attributed to this modification.

### ***Response to Arguments***

12. Applicant's arguments filed on 12/14/07 have been fully considered but they are not persuasive. The Examiner has responded to the arguments and amendments with in the above action, therefore please see above.

### ***Conclusion***

13. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHRISTIAN E. RENDÓN whose telephone number is (571)272-3117. The examiner can normally be reached on 9 - 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xuan Thai can be reached on 571-272-7147. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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